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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/691,896 10/19/00 THENO

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EXAMINER
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HM12/0523

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ART UNIT	PAPER NUMBER
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1619

DATE MAILED:

05/23/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/691,896

Applicant(s)

THENO, MARK H.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14, 16-31, 38-39 is/are rejected.
- 7) ☒ Claim(s) 2, 9 is/are objected to.
- 8) ☒ Claims 15, 32-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

During a telephone conversation with Janal Kalis on March 12, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14 and 16-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 32-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 16-31, and 38-39 drawn to a vapor emitting patch, classified in class 424, subclass 443.
- II. Claims 10, 11, 15, 32, and 36-37, drawn to perfumes, classified in class 512, subclass 1.
- III. Claims 10, 11, 33 and 35, drawn to insect repellant, classified in class 424, subclass 405.
- IV. Claims 10, 11, 34, drawn to a vapor gel, classified in class 604, subclass 23.

**Note:** Claims appearing in more than one group will be examined only to the extent that they read upon the elected invention.

Inventions of Group I and Groups II-IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a perfume, a cologne, an insect repellant, a vapor

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menthol gel, an aroma therapy substance, an air freshener, an animal scent, as recited by Applicant, and the inventions are deemed patentably distinct since there is nothing of record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions of Groups II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions can be used as a perfume to emanate an appealing smell and as an insect repellant to deter bugs.

### *Specification*

The disclosure is objected to because of the following informalities: pg. 3, lines 10-12: the sentence is confusing, "releasable" should be changed to "releasably". Appropriate correction is required.

### *Claim Objections*

Claims 2 and 9 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. Both the hydrogel and the vapor emitting material are recited in claim 1.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 14, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 6, 14 and 22 are rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language.

(ii) Regarding claim 24, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, 10-14, 16-31, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick et al. (6,010,715) in view of Norcia (6,033,684) and Folekemer et al. (3,318,769).

Wick et al. teach a transdermal patch incorporating a polymer film incorporated with an active agent. A device is disclosed as a laminate of (a) a monolithic carrier layer having a first surface and second surface, in which an active ingredient is enclosed, wherein the carrier layer is comprised of acrylics, (b) an active ingredient-impermeable backing layer having an inner surface and outer surface, wherein the inner surface is adhesively joined to the second surface of the carrier layer (c) a pressure-sensitive adhesive layer for affixing the laminate to the skin. The backing layer (film layer of instant application) is disclosed as polyethylene terephthalate, paper, or aluminum foil, which meets claims 14 and 22. Pressure sensitive adhesives are disclosed as cross-linkable laminating adhesives. Further embodiments of the invention are disclosed wherein the device provides a multiple-compartment assembly for applying a plurality of active agents/enhancers to the skin/mucosa of a host, which meets claims 16-24. Packaging the patches in pouches is disclosed, as is a method of using the patch wherein the patch is attached to skin, which meets claims 25-31, 38-39. The reference fails to teach a vapor emitting portion and a vapor emitting material. See Col. 1, line 19-Col. 4, line 55; Col. 6, line 54-Col. 19, line 2; Col. 19, line 10-Col. 24, line 45; Col. 24, line 45-Col. 28-31; Col. 30, line 14-Col. 38, line 47.

Norcia teaches compositions and methods for wound management. A hydrocolloid absorptive adhesive wound dressing is disclosed, wherein the outer film layer is vapor and oxygen permeable and is comprised of non-woven and woven materials. The absorbent dressing component is disclosed as a hydrogel. See Col. 3, line 1-Col. 6, line 28.

Folekemer et al. teach resin compositions comprising organophosphorus pesticides, wherein the resin is a solid. Polymers comprising the resin are disclosed as polyolefins, acrylate ester resins and others. It is disclosed that when the resin is kept in a sealed container, the resin

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composition may be stored for extended periods without appreciable decrease in pesticide content and that when the resin is removed from the container, the pesticide evaporates from the surface of the resin into the surrounding atmosphere. See Col. 1, line 14-Col. 5, line 41.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the patch of Wick et al. by substituting the outer film layer of Norcia et al. for the backing layer of Wick et al. to form a patch that is capable of emitting vapors because (a) both Wick et al. and Norcia teach pressure sensitive adhesives for attachment to the skin (b) both Wick et al. and Norcia disclose the layers as films comprised of polymeric materials. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the patch of the combined references by substituting the resin composition of Folekemer et al. for the carrier layer of the combined references to produce a patch that acts as an insect repellent because (a) Folekemer et al. teach an active agent melt blended with an organic macromolecular thermoplastic resin and Wick et al. teach that active agents suitable for use in the invention must be heat stable at the melt temperature of the matrix polymer and not react with the matrix polymer; (b) both Folekemer et al. and Wick et al. teach an active agent diffusing out of the resin/polymer matrix to produce a benefit. The method of applying the patch is inherent to the claimed patch because the patch is a pressure sensitive adhesive.

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

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***Prior Art***

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

***Comments/Notes***

The Examiner respectfully requests that Applicant correct the spelling of "adhesive" in claim 24.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
April 11, 2001

  
DAMERON L. JONES  
PRIMARY EXAMINER